

**REMARKS**

Claims 8 to 24 are now pending.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to paragraph one (1) of the Non-Final Office Action, claims 8 to 24 were rejected under 35 U.S.C. §102(b) as anticipated by Klatt, U.S. Patent No. 4,510,906.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

As regards the Office Action’s “Response to Arguments” (pages 2 and 3), the Office Action asserts that certain features (which Applicant asserts distinguishes the presently claimed subject matter from the asserted related art) are not in claims 8 and 16.

In particular, for example, this asserted as to the feature of “the setpoint engine speed”. In claims 8 and 16, the feature of “an output variable to be output by the drive unit” is specified in this regard, and in this context, it is clear that a setpoint value is involved for an output variable of the drive unit. Nevertheless, to better clarify the claimed subject matter claims 8 and 16 now provide as follows: “a setpoint value for an output variable output by the drive unit”.

The Klatt reference only refers to actual values in the form of actual engine speed explicitly for the shifting of the accelerator pedal pressure point, and that speed is recorded using a rotational speed sensor, in the form of the engine characteristics (that is, the type of motor used), and in the form of information concerning the motor temperature (column 2, lines 32 to 45). For all the variables named with the applied reference, what is involved -- as previously explained, are actual values of output variables or operating variables of the internal combustion engine.

In contrast, with the subject matter of claims 8 and 16, as presented, *the optimum operating point is determined as a function of the setpoint value of an output variable of the drive unit*, which is explicitly provided by claims 8 and 16 (“as a function of an output variable to be output by the drive unit”).

The Office Action further asserts that that the feature “a set point value for the output variable starts from the given set point value for the output value and a current operating variable of the drive unit the optimum operating point is determined” is not in claims 8 and 16. In this regard, the Office Action misquoted the corresponding text from page 6, second paragraph, of the prior response, so that its proper meaning was distorted. The following is the proper recitation: “a set point value for the output variable is accepted as given and starting from the given set point value for the output variable and a current operating variable of the drive unit the optimum operating point is determined and indicated by a haptic signal”. In fact, this does correspond, as a practical matter, to claims 8 and 16, which specifically recite the feature of “determining the optimum operating point as a function of an output variable to be output by the drive unit and as a function of an instantaneous operating variable of the drive unit”.

The foregoing plainly emphasizes the difference between the subject matter of claims 8 and 16, and the Klatt reference. In particular, it evidences that the Klatt reference shows exactly the opposite of the subject matter of claims 8 and 16. This is because claims 8 and 16 literally describe that the optimum operating point is determined as a function of a setpoint value of an output variable of a drive unit, and as a function of a current value of an operating variable of the drive unit. This simply means, as stated on page 6 of the prior response that starting from the setpoint value of the output variable of the drive unit, and starting from the current operating variable of the drive unit, the optimum operating point is determined. Consequently, this feature is plainly encompassed by and reflected in claims 8 and 16.

Moreover, the Office Action asserts that the feature “efficiency-optimal for every output variable” is not in claims 8 and 16. However, this citation is taken out of context, since in a complete manner -- and therefore correctly cited, it would read “efficiency-optimal for every output variable to be generated by the drive unit”. This is a benefit that is derived from the features of claims 8 and 16. In particular, if one specifies a setpoint value for an output variable that is output by the drive unit, as with claims 8 and 16, as presented, and if one determines the optimum operating point as a function of this, as with claims 8 and 16, then one is able to ascertain an optimum operating point for any desired setpoint value of the output variable output by the drive unit, as provided for in the context of the presently claimed subject matter.

*Following the comment on page 3, lines 6 to 7 of the Office Action, claims 8 and 16 have been clarified as to the use of the phrase “set point value”, since the phrase “to be” is deleted.*

*As regards claim 11, it has been clarified to make plain that the setpoint value for the output variable includes a setpoint torque.* Accordingly, claim 11 provides that “the set point value for the output variable includes a setpoint torque”.

As regards the Office Action’s assertions as to the connection of the setpoint torque and the recommendation for gear shifting, and as previously explained, the gear shifting recommendation has nothing to do with the specification of a setpoint torque.

As previously explained, regarding independent claims 8 and 16, the Non-final Office Action asserts that the Klatt reference discloses that an optimum operating point is determined as a function of: 1) an output variable to be output by the drive unit; and 2) an instantaneous operating variable of the drive unit. While Klatt may refer to adjusting the position of stop 3 as a function of engine speed and/or engine characteristics, it is respectfully submitted that Klatt does not disclose the operating point as a function of a setpoint value for an output variable output by the drive unit, as provided for in the context of the claimed subject matter.

In this manner, the subject matter of claims 8 and 16 provides the advantage that an optimal operating point of the drive unit may be set even for an output variable to be generated. In contrast, the “Klatt” reference in no way ensures that at the operating point of the highest engine efficiency, at which the pressure point on the accelerator pedal is reached, a specified setpoint, for example, for an output variable of the drive unit can also be reached. The behavior of the internal combustion engine in the subject matter of the “Klatt” reference is therefore not efficiency-optimal for every output variable to be generated by the drive unit. This is evidenced when the driver overrides the pressure point of the accelerator pedal to initiate a safe passing operation (col. 2, lines 62 to 68). In this operating state, the optimal efficiency set in accordance with the “Klatt” reference cannot account for the further variable of an output variable to be generated.

That is, in such a passing operation, the subject matter of the “Klatt” reference offers no operating point having an optimal efficiency which accounts for the setpoint value for the output variable output by the drive unit. Thus, with claims 8 and 16, if the optimal operating point is made a function of a setpoint value for the output variable output by the drive unit, then it is possible to signal to the driver an optimal operating point in every operating state of the drive unit and to consume even less fuel in this manner.

Accordingly, the “Klatt” reference does not identically disclose or suggest the features discussed above, so that claims 8 and 16, as presented, are plainly allowable for the foregoing reasons. Claims 9 to 15 depend from claim 8, as presented, and are therefore allowable for the same reasons as claim 8, as presented. Claims 17 to 24 depend from claim 16, as presented, and are therefore allowable for the same reasons as claim 16, as presented.

As further regards dependent claims 11 and 18, the Non-final Office Action asserts that “the output variable includes a setpoint torque ([3, 1-15] shift gears; [2, 32-45] the engine).” It is respectfully submitted that the text at column 2 (lines 32 to 45) refers only to the current engine speed, the current engine temperature and the engine characteristic. That is, the type of engine used. The text at column 3 (lines 1 to 15) concerns a driver who is able to receive a gear shift recommendation via the gas pedal, where control 9 moves wedge 3 slightly back (to the left) as soon as a suitable rotational frequency is reached and the load conditions permit a shift. The driver thus detects that an upshift is expedient without being distracted from traffic. The same effect may also be achieved by a short impulse, that is, a back-and-forth movement of wedge 3.

Such a gear shift recommendation simply does not disclose the claim 11 feature in which the optimum operating point is determined as a function of a setpoint torque as an output variable output by the drive unit. The gear shift recommendation is not the operating point as a function of a setpoint value of an output variable output by the drive unit as with claims 8 and 16, as presented, but concerns a signaling of how a higher engine efficiency factor may be achieved, without consideration of an output variable to be output by the drive unit.

Accordingly, claims 8 and 16, and their respective dependent claims, are allowable for the foregoing reasons.

In summary, it is respectfully submitted that all of claims 8 to 24 are allowable for the foregoing reasons.

### CONCLUSION

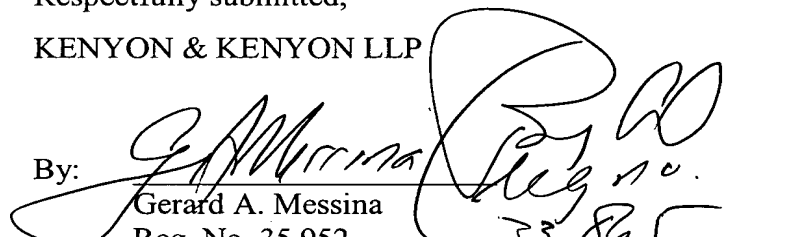
It is therefore respectfully submitted that all of the presently pending claims are allowable and it is respectfully requested that the rejections (and any objections) be withdrawn. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,  
KENYON & KENYON LLP

Date:

4/17/2008

By:

  
Gerard A. Messina  
Reg. No. 35,952  
One Broadway  
New York, New York 10004  
(212) 425-5288  
*33,865*  
*Amc*  
*DEDITCH*

**CUSTOMER NO. 26646**